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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,808	03/11/2002	Shoji Ichinohe	TAKIT 167	9568

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 08/14/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,808

Applicant(s)

ICHINOHE ET AL.

Examiner

Lakshmi S Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Receipt of preliminary amendment dated 3-11-02 is acknowledged.

Claims 1-33 are pending.

The references cited in the Search Report dated 10-16-2001 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9, 10, 12, 14-17 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,641,239 (hereafter '239).

'239 teach a cosmetic wax composition comprising in a wax base, a coloring agent and an organic wax made of silicone wax. The silicone wax of '239 is a silicone-carnauba wax copolymer in which a silicone moiety is bonded to the wax moiety through a divalent organic radical comprising 2 to 92 carbon atoms (col. 2, lines 3-6). '239 teach that the divalent radical

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links silicone and wax moieties predominantly by ether but also by ester linkages (col. 7-8, col.9, lines 1-11). In col. 11, '239 teaches that the ether linkages are formed between the hydroxyl radicals of carnuba wax and the ester linkages are formed by the acid linkages, which depends on the amounts of unreacted carboxylic groups in carnuba wax (lines 50-67). '239 also teach that the epoxy bearing radical reacts with the silicon atoms resulting in the silicon modified carnuba wax (col. 12-13). '239 teach using the carnuba wax prepared by the above method for preparing lipstick compositions containing other components such as coloring agents, solvents including monohydric or polyhydric alcohols, vegetable oils or waxes that read on the claimed unctuous agents, polysiloxanes, fatty acid esters (which read on the instant surfactants) (col. 16, 17). '239 teach that the silicone wax can be used in preparing cosmetic compositions such as lipsticks, mascara, solid perfume, chapstick, eyebrow stick etc.

'239 teach differ from the instant claims in that the predominant linkages between silicone and wax moieties are ether linkages, while instant composition claims a silicone-modified wax material containing ester linkages. However, '239 states that carnuba wax varies greatly in the amounts of free acids, alcohols and that partially hydrolyzed carnuba wax used for producing silicone-modified wax contains unreacted carboxylic groups that result in the production of ester linkages. Further, '239 explains that the term "predominant" implies up to 60% ether linkages and any remaining linkages are of ester type. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare a carnuba wax modified with silicone by hydrolyzing carnuba wax and reacting the unreacted carboxylic acid with silicone via an epoxy group with an expectation to produce a silicone modified wax having ester linkages (col. 11, l 61-67) that exhibits an improved viscosity stability

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and yet retain all the properties of wax, when employed in a cosmetic composition such as a lipstick, mascara etc. Further, '239 teach several cosmetic additives explained above and accordingly, incorporating a surfactant or a colorant etc., in the composition containing wax, for their art recognized effect is within the scope of a skilled artisan. With respect to the claims 30 and 31, the mere recitation of the limitations (UV protectant or antiperspirant) in the preamble does not carry a patentable distinction and the claims still read on a cosmetic composition.

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,219,560 to Suzuki et al ('560) in view of US 3,641,239 (hereafter '239).

'560 teach cosmetic compositions comprising acrylic-silicone graft copolymers having an organosiloxane side chain for use in skin, hair and nail care compositions. The acryl-silicone copolymer of '560 is prepared by radical polymerization of a dimethyl polysiloxane having a polymerizable radical group and a radically polymerizable monomer comprising an acrylate or methacrylate or both (col. 2, lines 25-65). The composition of '560 further contains low viscosity silicone oil or a cross-linked organopolysiloxane, cosmetic powder, surfactant, volatile solvent etc (col. 2, lines 1-14). The acryl-silicone polymer of '560 meets the requirement of acrylic silicone of claims 24-26 (col.3-4). '560 teach incorporating the silicone polymer in compositions such as lipsticks, mascara, foundation etc (col. 5, lines 53-66). '560 also teach incorporating powders such as silicone (paragraph between col. 11-12), homopolymers of acrylic acid for increasing viscosity (col. 12), surfactants, pigments etc (examples) and also teach preparing the composition in an o/w or w/o emulsions. Examples 16-19 also teach the addition of wax such as carnuba wax, bees wax etc. '560 does not teach the claimed silicone-modified wax.

'239 described above teach carnuba wax modified by silicone. '239 teach the formulation of cosmetic compositions such as lipsticks involves the problem of leaching-out or streaking of the colors and result in heterogenous formulation. In order to avoid the color separation and retain homogeneity, and also produce a durable film forming composition, '239 suggests adding silicone-carnuba wax that reads on the instant claimed silicone-modified wax (see above). It would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add the silicone-carnuba wax of '239 in place of the carnuba wax or other type of wax in the cosmetic compositions containing acrylic-silicone polymers of '560 because '239 teach that the silicone-carnuba wax exhibits an improved stability and have a sharper melting point that helps retain the properties of the composition to the melting point of wax and thus have an improved performance over the compositions that do not contain silicone-carnuba wax.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala
Examiner
Art Unit 1615
August 12, 2003